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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/311,313	05/13/99	MCBRIDE	J 10971316-1

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EXAMINER

GARBOWSKI, L

ART UNIT

PAPER NUMBER

2825

DATE MAILED: 10/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/311,313

Applicant(s)

MCBRIDE, JOHN G

Examiner

Leigh Marie Garbowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 May 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. This application has been examined.
2. The following is a quotation of the first paragraph of 35 U.S.C. 112:
3. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Taking claim 1 as exemplary, the claim does not appear to recite any features other than the concept already set out in the preamble. In other words, the body of the claim appears to be defined upon itself, the features of which were already recited in the preamble. It is not particularly clear what subject matter the applicant is claiming, thus rendering the claim is incomplete and vague.
6. Further as per claim 14, the claim recites "steps" [line 3] yet only one step follows. Thus, the claim is confusing.
7. The remaining claims, though not specifically mentioned, are rejected for incorporating the errors of their respective base claims by dependency.
8. The following rejections are based on the examiner's best interpretation of the claims in view of the issues raised above.
9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
10. A person shall be entitled to a patent unless –
11. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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12. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
13. Claims 1, 14, and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kuhns ["Automating Testability Analysis of Analog Circuits and Systems".
14. Taking claim 14 as exemplary [claims 1 and 19 are considered rejected but such is omitted for sake of brevity], Kuhns discloses a method for determining whether or not an element of a network comprised in an IC is a feedback element, the method comprising the step of: analyzing information relating to the network to determine whether or not an element comprised in the IC is a feedback element [page 230, "Testability Rules" section].
15. Claims 1-2, 11, 14-15, 19 and 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Schuelein et al. [U.S. Patent #6,113,648].
16. Taking the claim 1 set as exemplary [claims 14-15, 19 and 22 are considered rejected but such is omitted for sake of brevity], Schuelein et al. disclose an apparatus for determining whether or not an element of a network comprised in an IC is a feedback element, the apparatus comprising: logic configured to analyze information relating to the network to determine whether or not an element comprised in the IC is a feedback element [column 10, lines 17-18]. As per claim 2, Schuelein et al. further disclose wherein said logic is a computer configured to execute a rules checker program, wherein when the rules checker program is run on the computer, the rules checker program analyzes the

information relating to the network to determine whether or not the element is a feedback element, wherein the element is field effect transistor [column 10, lines 17-33]. As per claim 11, Schuelein et al. further disclose wherein the rules checker program determines whether or not the transistor being evaluated is a feedback element by determining whether or not the transistor is comprised of a particular type of circuit, the particular type of circuit corresponding to a special case, wherein if the rules checker program determines that the element being evaluated is comprised in the particular type of circuit, the rules checker program determines that the transistor being evaluated is a feedback element [column 10, lines 17-33].

17. Claims 1, 14, and 19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by McElvain [U.S. Patent #6,182,268 B1].
18. Taking claim 14 as exemplary [claims 1 and 19 are considered rejected but such is omitted for sake of brevity], McElvain discloses a method for determining whether or not an element of a network comprised in an IC is a feedback element, the method comprising the step of: analyzing information relating to the network to determine whether or not an element comprised in the IC is a feedback element [column 6, lines 38-65; column 7, lines 15-16].
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
20. Allred [U.S. Patent #5,734,798] discloses identification of feedback paths including FETs.

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21. McBride [U.S. Patent #5,987,237] discloses rules checking.

22. Claim 3-10, 12-13, 16-18, and 20-21 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh Marie Garbowski whose telephone number is 703-305-9753. The examiner can normally be reached on weekdays from 9am to 5pm.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Smith, can be reached on (703) 308-1323. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3431.

25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

 Leigh Marie Garbowski

September 27, 2001



MATTHEW SMITH
SUPERVISORY PATENT EXAMINER
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